



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/201,107	11/30/1998	CHRISTIAN MAYAUD	CM3-CON	1150

20277 7590 06/19/2003
MCDERMOTT WILL & EMERY
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

EXAMINER

KEMPER, MELANIE A

ART UNIT PAPER NUMBER

3622

DATE MAILED: 06/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/201,107

Applicant(s)

MAYAUD, CHRISTIAN

Examiner

M Kemper

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 70-83 and 85 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 85 is/are allowed.
- 6) ☒ Claim(s) 70,74 and 76-83 is/are rejected.
- 7) ☒ Claim(s) 71-73 and 75 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 20.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 2-25-03 has been entered.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 76 is rejected under 35 U.S.C. 102(b) as being anticipated by Fox, Gary N., "S-O-A-P Drug Interaction Program with Drug Side Effects and Automatic Prescription Writing" Journal of Family Practice, v. 36, n. 5, p. 573(2).

Fox teaches a prescription creation software implemented on a computer comprising: a prescription creation screen display, permitting prescriber-operable data capture of information including patient identifying data, prescribed drug identification data and drug quantification data (p. 1-2, "In addition to 20 drugs per patient, SOAP allows entry of identifying data (eg name..." "To each diagnosis or drug entry, SOAP allows 'attaching' 18 characters of optional text, sufficient to abbreviate prescription information (eg, '400 mg ltid #60 rf0').", "When the prescription writer is accessed, all of

Art Unit: 3622

the patient's drugs are listed; the physician selects which to print as prescriptions. Each prescription is then previewed on the screen. For some drugs, there is a preexisting default prescription (quantity, number of refills, instructions) and chart documentation (the 18 character entry described earlier.); and a prescription output device to output a prescription completed with patient, prescribed drug and prescribed drug quantifier information (p. 1-2, printer for printing prescriptions) and comprising a drug contraindication review routine automatically activatable from the prescription creation system prior to dispatch of the completed prescription for fulfillment, the drug contraindication review routine accessing contraindication information regarding the prescribed drug and generating an alert regarding a relevant such contraindication (p. 1-2, performs drug-drug and drug-disease interactions and drug side effects and allergy alerts, "The advantages of the electronic version include its automatic tagging of drug-drug and drug-disease interactions...").

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 79-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenberg, David, "The Application of Future Technologies to Medical Informatics", Physician Executive, v. 20, n. 1, p.(5), January 1994 in view of Kirk et al., patent number 5,655,116.

Greenberg teaches a computer-implemented patient history record display system having a program embodied on a computer-readable medium, the system being operative to display an electronically generated medical history of a patient at multiple record-independent facilities, the history record comprising a patient identifier wherein the patient history record is a virtual patient record newly assembled online from multiple separate components respectively obtained from multiple remote source databases in response to a system user request for the patient history record (p. 3-4, "Distributed databases...we can create the virtual medical record which exists only as a query that returns data from the database servers at the clinic, hospital, and lab simultaneously"); and a user interface device configured for networked communication with a host wherein the record is retrieved in the form of complementary record elements from multiple remote databases by the host (p. 3-4). The article does not specify a prescription history of the patient, however, it would have been obvious to one having ordinary skill in the art at the time of the invention to have included prescription histories including the prescribed drug and drug quantifier since this information is included in a patient's medical file and since Greenberg includes listing medications as part of the record (p. 2).

Kirk et al. teaches retrieving information from dissimilar databases distributed throughout a network in response to a user query for information and a contemporaneous record dynamically assembled from multiple source record elements retrieved from multiple heterogeneous remote databases, and a user interface device configured for networked communication with a host wherein the record is retrieved in

Art Unit: 3622

the form of complementary record elements from multiple remote databases by the host (abstract, col. 1, lines 5-10, col. 4, line 60- col. 5, line 3, col. 5, lines 50-55). It would have been obvious to one having ordinary skill in the art at the time of the invention to have used the retrieval of Kirk et al in the system described in Greenberg since the retrieval of Kirk would have generated the virtual record desired and directly suggested in Greenberg. It also would have been obvious to have a patient condition list for selection of a patient condition since this would have been adopted for the intended use of providing a user-friendly interface for the user in particular with respect to the "chronic and acute problems lists" taught in Greenberg (p. 2). Greenberg also teaches source-oriented data-retrieval subsystem to access at least one data-retrieval network to retrieve source prescribing information and patient-related data to the point of care from at least one remote source database (p. 2-3).

6. Claims 79-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beck et al., 'At Last : Integrated Diagnostic Images, Medical Records, & More – Networked" Advanced Imaging, v.8, n.11, p. 26(5), November 1993 in view of Kirk et al., patent number 5,655,116.

Beck teaches a computer-implemented patient history record display system having a program embodied on a computer-readable medium, the system being operative to display an electronically generated medical history of a patient at multiple record-independent facilities (p. 1, "VCS presume the existence of networked multiple servers, each with some unique data that is occasionally needed by people elsewhere within the community or clinical environment. For VCS this preserves some of the best

Art Unit: 3622

features of the clinic-based record system, while enhancing access and integration; it's not a mammoth central electronic patient record, but a functionally decentralized one."; p. 6, "Ben Taub Hospital will be the central clinic site and will house the Unix servers supporting all operational and project related applications. The Ben Taub site will provide Ethernet communications within the clinic and between clinics and hospital information systems such as the master patient index (ADT), laboratory, diagnostic imaging, etc.)", the history record comprising a patient identifier wherein the patient history record is a virtual patient record newly assembled online from multiple separate components respectively obtained from multiple remote source databases in response to a system user request for the patient history record (p.1 as shown above, p. 2, "The unique ability of the VCS to address data servers on the Internet will allow us to extend this system in different geographical locations should patients relocate. The VCS is designed as a work group application to incorporate the best aspects of an integrated distributed medical data model, allowing specialty specific views of the data, access to all views of the record, and notification of updates to any virtual patient chart:", p. 3, "An integrated, multimedia, distributed model will permit data sharing, security, and user-defined view of the patient record";). The article does not specify a prescription history of the patient, however, it would have been obvious to one having ordinary skill in the art at the time of the invention to have included prescription histories including the prescribed drug and drug quantifier since this information is included in a patient's medical file.

Kirk et al. teaches retrieving information from dissimilar databases distributed throughout a network in response to a user query for information and a contemporaneous record dynamically assembled from multiple source record elements retrieved from multiple heterogeneous remote databases, and a user interface device configured for networked communication with a host wherein the record is retrieved in the form of complementary record elements from multiple remote databases by the host (abstract, col. 1, lines 5-10, col. 4, line 60- col. 5, line 3, col. 5, lines 50-55). It would have been obvious to one having ordinary skill in the art at the time of the invention to have used the retrieval of Kirk et al in the system described in Beck since the retrieval of Kirk would have generated the virtual record desired and directly suggested in Beck for the user-defined view of the record. It also would have been obvious to have a patient condition list for selection of a patient condition since this would have been adopted for the intended use of providing a user-friendly interface for the user. It also would have been obvious to have a source oriented data retrieval subsystem since this would have at least provided a narrow search result such as lab results from a particular lab versus all lab results.

7. Claim 77, 78 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fox as above.

Fox does not specifically state that the contraindication information is from a remote source database. However, it would have been obvious to one having ordinary skill in the art at the time of the invention to have linked to a data retrieval subsystem to obtain the contraindication information since this would have been adopted for the

Art Unit: 3622

intended use of providing the most up to date information on drug interactions as well as providing a complete listing of drug contraindications (as opposed to a listing constrained by the limits of the user's computer system).

8. Claims 70, 76 are rejected under 35 U.S.C. 102(b) as being anticipated by Halvorson, patent number 4847764.

Halvorson discloses a system for entering prescriptions at a physician console and for dispensing the drugs prescribed at dispensing locations. The system utilizes a database comprising drug information (col. 8, lines 5-31) including generic and brand names and formulary indicator, generic drug information (col. 8, lines 32-68) including generic drug name and drug interaction codes, patient identification information (col. 9, lines 51-68) including patient identification number, date of birth, personal data and description of allergies, and patient history and medication history information (col. 10, line 1 et seq.). As disclosed in column 2, line 53, and column 4, lines 47-55, Halvorson's system includes automatic drug-interaction and allergy warnings. Specifically Halvorson teaches a prescription creation screen permitting capture of patient-identifying data, drug identification data, and drug quantification data and an output device to output the prescription (col. 3, lines 15-30, col. 10, lines 1-45) and comprising a drug contraindication review routine automatically activatable from the prescription creation system prior to the dispatch of the completed prescription for fulfillment (col. 2, lines 50-55, col. 4, lines 45-55).

9. Claims 70, 74 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Halvorson, patent number 4,847,764 in view of Heuer et al., "Drug Industry – Industry Report" Smith Barney: New York.

To the extent that the claim can be interpreted differently in view of Halvorson, Heuer teaches drug formulary information identifying at least one of multiple drugs as a patient's drug formulary preferences to enable selection by the prescriber of a benefit plan recommended drug (whole document). It would have been obvious to one having ordinary skill in the art at the time of the invention to have linked the physician/user of Halvorson to the patient's formulary information as in Heuer since the formulary preferences of Heuer would have been adopted for the intended use of controlling medication costs.

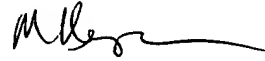
10. Claims 71-73, 75 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M Kemper whose telephone number is 703-305-9589. The examiner can normally be reached on M-F (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Art Unit: 3622

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



M Kemper
Primary Examiner
Art Unit 3622

MK
June 2, 2003